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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,136	01/21/2005	Dieter Raab	23146	4144

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THE FIRM OF KARL F ROSS
5676 RIVERDALE AVENUE
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EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/523,136

Applicant(s)

RAAB, DIETER

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The finality of the rejection of the last Office action dated 25 September 2006 is withdrawn.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: (a) Fig. 1, reference numbers (29) and (32). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 8, lines 22-24, it is unclear as to Applicant's intent of the claim limitation "the bore having a depth such that the pin in an inner position is wholly received in the bore and does not project from the bore into the groove". The submitted specification and figures do not clearly describe or show the specific claimed limitation with respect to the "inner position". Specifically, figures 5-7 clearly show the pin (21) being received in the bore (27) and extending into the groove (17). No "inner position" is shown or described that provides support to the claimed limitation.

6. Regarding claim 8, lines 25-27, it is unclear as to Applicant's intent of the claim limitation "a retaining element removably received in the cartridge and projecting radially into the bore at a location impeding movement of the pin into the inner position". The submitted specification and figures do not clearly describe or show the specific claimed limitation with respect to the "inner position". Specifically, figures 5-7 clearly show the retaining pin (25) projecting radially into the bore (27) impeding movement of the pin upwardly. No "inner position" is shown or described that provides support to the claimed limitation.

7. Regarding claim 14, lines 18-19, it is unclear as to Applicant's intent of the claim limitation "a retaining body centered on and rotatable about an axis generally parallel to the groove axis". The submitted specification and figures do not clearly describe or show the specific claimed limitation with respect to the "rotatable about an axis". Specifically, figures 1-4 clearly show the retaining body (33) being centered on and moveable about an axis generally

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parallel to the groove axis. No "rotatable about an axis" is shown or described that provides support to the claimed limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-10,13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundgren '125. Lundgren '125 shows in Figures 1-9 a cutting-tool assembly comprising a rotatable tool holder (31) formed with an outwardly open seat (longitudinal surface 39 and a transverse surface 40a) having an outwardly directed floor (39a), a cartridge (29,30) engaged in the seat carrying a cutting insert (32) and formed with an inwardly open groove (col. 3, lines 2-5) defining a groove axis and having a surface confronting and extending at a small acute angle to the seat floor (Figs. 2,3 and 9), and a radially extending bore (51) opening into the seat. Lundgren '125 shows an adjustment wedge (37,44) axially shiftable in the groove (Fig. 9) having a formation (shape of wedge,54) extending transversely on the axis and bearing radially outward on the groove surface and radially inward on the seat floor whereby axial shifting of the adjustment wedge radially shifts the cartridge in the groove (col. 3, line 2-11). Lundgren '125 shows an eccentric pin (50,52,53) seated and rotatable in the bore and engaging the formation of the adjustment wedge (Fig. 5) for axially shifting the adjustment wedge in the groove thereby radially displacing the cartridge in the seat, the bore having sufficient depth that the pin is wholly received on the bore (Fig. 5) and does not project into the groove, and a retaining element (52) removably received in the cartridge and projecting radially into the bore at a location impeding movement of the pin. Lundgren '125 shows the formation being a transverse groove (54) in the

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adjustment wedge (37) and the eccentric pin has a cylindrical end extension (53) engaged in the transverse groove. Lundgren '125 shows the wedge angle is between 8° and 12° (page 3, lines 54-55). Lundgren '125 shows a retaining body (70) centered and moveable about an axis generally parallel to the groove axis for pressing against the cartridge and thereby locking the cartridge against displacement in the seat (Fig. 7).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundgren '125. Lundgren '125 further shows the seat floor (39a) being flat and the wedge having a flat face (39b) riding on the seat floor. Lundgren '125 does not disclose expressly that "the inwardly open groove surface of the cartridge is generally cylindrical in shape". Instead, Lundgren '125 indicates that the "inwardly open groove surface of the cartridge is generally flat in shape (at 44 in Figs. 3 and 9). At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "the inwardly open groove surface of the cartridge to be generally cylindrical in shape" because Applicant has not disclosed that "the inwardly open groove surface of the cartridge is generally cylindrical in shape" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the cutting-tool assembly of Lundgren '125, and Applicant's cutting-tool assembly to perform equally well with either the "inwardly open groove surface of the cartridge is generally flat in shape" as taught by Lundgren '125 or the claimed "the inwardly open groove surface of the cartridge is generally cylindrical in

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shape” because both shapes would perform the identical function to guide the axially adjustable wedge along a complementary surface of the cartridge to radially displace the cutting insert.

Furthermore, Applicant does not provide any criticality or unexpected results for “the inwardly open groove surface of the cartridge is generally cylindrical in shape” as recited in claim 11.

Response to Arguments

12. Applicant's arguments with respect to claims 8-14 filed 07 December 2006 have been considered but are moot in view of the new ground(s) of rejection. As stated above, the finality of the rejection of the last Office action dated 25 September 2006 is withdrawn.

Conclusion

13. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

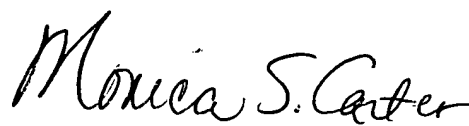
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MWT
Examiner
25 January 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER